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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,757	07/01/2003	Leslie G. Christie JR.	200206842-1	5562

22879 7590 10/13/2006

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EXAMINER

TRAN, KHOI H

ART UNIT PAPER NUMBER

3651

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,757

Applicant(s)

CHRISTIE, LESLIE G.

Examiner

Khoi H. Tran

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 2-7 and 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

KHOI H. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group III, represented by claims 1 and 8-15 in the reply filed on 09/14/2006 is acknowledged. The traversal is on the ground(s) that since the newly amended claim 1 contains similar features in independent claim 21, the restriction requirement for Group V should be removed. This is not found persuasive. Applicant amended claim 1 to include a generic term "controller" for the claimed storage system. The particulars of the computer product within the controller are not claimed per claims 21-25. Hence, claims 21-25 of Group V remain distinct and the two groups are still restrictable under subcombinations disclosed as usable together in a single combination.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 11, "a reference guide" lacks positive identification. It is not distinct whether said guide is actually part of the claimed invention. In addition, the spatial location of the reference guide is not distinct. Applicant is required to positively identify the "reference guide" as part of the actual claim combination.

In regards to claim 12, "the drive member" lacks antecedent basis.

In regards to claim 13, "a slotted opening" lacks positive identification. It is not distinct whether said opening is actually part of the claimed invention. Applicant is required to positively identify the "slotted opening" as part of the actual claim combination.

In regards to claim 14, "an adjustable mount" lacks positive identification. It is not distinct whether said opening is actually part of the claimed invention. Applicant is required to positively identify the "adjustable mount" as part of the actual claim combination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 8-12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Marlowe 5,856,894.

Marlowe '894 discloses a storage system per claimed invention. The system comprises a movable accessor and a cartridge transport device configured to move plurality of cartridges a long a path (Figures 1-3 and 7). The path includes a front side and a backside. The system comprises a controller for controlling the accessor and the transport device. The controller is configured to operate the transport device to move a first group of cartridges from the front side to the backside to allow the accessing of the

cartridges on the backside by the movable accessor. The accessor and the cartridge transport device are capable of simultaneously operating.

The Marlowe '894 system comprises a mounting system capable of supporting the transporting device (Figures 3-5E) and a magazine configured to store at least one cartridge. The mounting system includes at least one support member and a magazine guide attached to the support member (Figures 4C & 4D or Figure 5E). Per Figures 5E and 5E', the magazine guides 53a' and 53b' comprise reference edges configured to engage reference guides 53a and 53b. The magazine guides and reference guides provide an adjustable mounting system for the cartridge transport device.

The Marlowe '894 magazine guide comprises a roller coupled to a drive member and the roller includes a flange at one end (Figure 4D). The flange includes a reference edge configured to engage a reference guide on the magazine.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marlowe 5,856,894.

In regards to claim 13, Marlowe '894 discloses all elements per claimed invention as explained in paragraph 5 above. However, it is silent as to the specifics of a key rod within the roller. Nevertheless, it is obvious that the drive shaft in Figure 5E would

contain a key rod that extends through an opening of roller 26U to provide attachment means for the drive shaft and roller arrangement.

In regards to claim 15, Marlowe '894 discloses all elements per claimed invention as explained in paragraph 5 above. However, it is silent as to the specifics of the mounting system being stackable. Nevertheless, it would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have vertically stacked plurality of Marlowe '894 storage devices, having the same exact mounting system, to facilitate the physical expansion of the storage system.

Conclusion

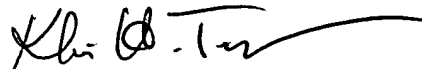
8. Additional references made of record and not relied upon are considered to be of interest to applicant's disclosure: see attached USPTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3651

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoi H Tran
Primary Examiner
Art Unit 3651

KHT
10/10/2006